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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,976	07/10/2003	Toru Futami	240108US3	3393
22850 7590 11/04/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER LEUNG, JENNIFER A				
ART UNIT 1797		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

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CONTINUATION SHEET

Item 3(a) NOTE.

The newly added limitations in claims 1 and 24, which call for said confluent portion and said branch portion to include an aqueous phase channel and an organic phase channel, raise new issues that require further consideration.

Item 11.

The request for reconsideration has been considered, but it does not place the application in condition for allowance, for the same reasons set forth in the final Office Action.

Applicant (at paragraph bridging pages 8 and 9) notes various deficiencies in the Giddings reference. Applicant's arguments, however, are not found persuasive, because Giddings was merely relied upon as a secondary reference for its teaching of inlet and outlet splitters. One having ordinary skill in the art would have been motivated to provide inlet and outlet splitters (as partition walls) in connection with the confluent and branch portions in the apparatus of Young et al., because the splitters would improve the splitting of the plural fluid streams into the physically distinct laminae at the entrance and exit of the fine channel, as taught by Giddings. In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant (at second paragraph on page 9) further notes the deficiency of continuous partition walls in connection with the walls of the channels in the apparatus of Christel et al. Applicant points out that the microcolumns 111 (i.e., partition walls) in the apparatus of Christel et al. are, instead, spaced from the walls of channels 101, 102 (see FIG. 5). Applicant's argument, however, is not found persuasive, because the argued features (i.e., continuous partitions walls) are taught by the secondary reference to Giddings. One having ordinary skill in the art would have been motivated to provide inlet and outlet splitters (as continuous partition walls) in connection with the confluent and branch portions in the apparatus of Christel et al., because the splitters would improve the splitting of the plural fluid streams into the physically distinct laminae at the entrance and exit of the fine channel, as taught by Giddings.

Regarding the newly added limitations that the channels include an "aqueous phase" channel and an "organic phase" channel, expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, inclusion of a material or article worked upon by a structure being claimed does not impart patentability to the claims. *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935); *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963).

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In the instant case, the modified apparatuses of Young et al. and Christel et al. would be capable of processing an aqueous phase material and an organic phase material. Young et al., for example, discloses that the fluids to be processed may include immiscible fluids, wherein aqueous and organic fluids are suggested (see, e.g., section [0005], [0046]). Christel et al. similarly discloses that the fluids to be processed may include immiscible fluids, such as polar and non-polar fluids (see, e.g., column 2, lines 56-67; column 6, lines 12-26).

* * *

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER A. LEUNG whose telephone number is (571) 272-1449. The examiner can normally be reached on 9:30 am - 5:30 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Jennifer A. Leung/
Primary Examiner, Art Unit 1797